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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/127,059	07/31/1998	AMEDEO LEONARDI	648/1D340-US	9662

7590 12/31/2001  
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EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 12/31/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/127,059

Applicant(s)  
LEONARDI et al.

Examiner  
Emily Bernhardt

Art Unit  
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/15/01 (RCE request).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) 6-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, and 5 is/are rejected.
- 7) ☒ Claim(s) 3, 19, and 20 is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 22
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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**A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/15/01 has been entered.**

**Claims 1,2,4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**1.The rejection of the previous actions still remain regarding the nature of the**  

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**resulting rings that form when B is fused. It is not seen how ortho monovalent**  
**groups such as alkyl,alkoxy... alkylamino can even form rings when there is no**  
**remaining available bond in any of these groups. The examiner has repeatedly**  
**indicated the 2 ring systems that are clearly indicated at this location. There is**  
**nothing else in the specification that provides further guidance.**

**The 102 and 103 rejections have been overcome by amendment to the**  
**claims or applicants' remarks regarding the nature of substitution on phenyl**

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in prior art. Plilai is also withdrawn in view of the indicated lack of sufficient biological activity disclosed in the reference as applicants urge. It is also noted that previously anticipated compound in Ananthanarayan was not tested for any activity. However the following references apply.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota (WO'329). The WO publication, newly cited by applicants, which published within a year of applicants' US filing date discloses similar compounds to that embraced herein for use in treating arthritis among others. See compounds in table 1.1 nos. 1,7-9. While these compounds

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do not anticipate the instant scope because of the presence of the methylene between phenyl and piperazine ring, they are obvious variants since the reference also teaches direct attachment of said phenyl ring. See definition of "m" in 1st choice for R4 on p.6. Thus it would have been obvious to one skilled in the art at the time the invention was made to remove the methylene in

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**aforementioned compounds and thus obtain instant compounds for using as taught by Shiota.**

**Claims 1,2,4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janssen (US'367). This reference is also of record having been provided in the IDS of 2/24/99. Janssen teaches similar compounds to that claimed for use as analgesics, and appetite suppressants. While said compounds (egs.1-4) do not anticipate the claims in view of proviso (1), they are obvious variants as they only differ in being unsubstituted in one of the phenyl rings vs. instant Me (i.e. alkyl) substituted phenyl. H vs Me is not considered a patentable advance absent evidence of superior, unexpected results. Note In re Wood 199 USPQ 137; In re Lohr 137 USPQ 548; In re**

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**Fauque 121 USPQ 425. Thus it would have been obvious to one skilled in the art at the time the invention was made to expect compounds claimed herein that are methylated on the one of the phenyl rings to also possess the uses taught by the art in view of the close structural similarity outlined above.**

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Claims 3,19-20 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 21 is now allowed.

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

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*E Bernhardt*

**EMILY BERNHARDT**

**PRIMARY EXAMINER**

**GROUP 1600**